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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,140	01/09/2004	Yasushi Fujinami	275927US6CONT	7496

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

ADEGEYE, OLUWASEUN

ART UNIT	PAPER NUMBER
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2621

NOTIFICATION DATE	DELIVERY MODE
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01/10/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/754,140

Applicant(s)

FUJINAMI ET AL.

Examiner

Oluwaseun A. Adegeye

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01/09/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 87 is/are pending in the application.
- 4a) Of the above claim(s) 1 - 15 and 60 - 63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16 - 59 and 64 - 87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01/09/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 08/24/2007.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 20, 28, 32, 40, 44, 52, 56, 64, 68, 76 and 80 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a

terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 16, 20, 28, 32, 40, 44, 52, 56, 64, 68, 76 and 80 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,697,566 in view of Yogeshwar et al (US 6,026,232).

Regarding **claims 16, 20, 28, 32, 40, 44, 52, 56, 64, 68, 76 and 80** of this application, claim 9 of U.S. Patent No. 6,697,566 recites a recording/reproducing apparatus, comprising:

stream file generation means for generating stream files containing video and/or audio signals; the stream files being composed of MPEG compressed video data;

characteristic point information generation means for generating plural types of characteristic point information from the video and/or audio signals contained in each stream file generated by said file generation means;

the characteristic point information including positional information indicating a user designated position and characteristic point information;

the characteristic point information being included in a program information file corresponding to each stream file and being used to access characteristic points when reproducing the stream files;

recording means for recording the stream files and corresponding program information files containing the plural types of characteristic point information in a recording medium, the program information files being recorded in a different area of said recording medium than the stream files;

the type of characteristic point information being correlated with a record position of the characteristic point information; stream file reproducing means for reproducing

the stream files which contain video and/or audio signals recorded on said recording medium; characteristic point information reproducing means for reproducing the plural types of characteristic point information from a program information file corresponding to each stream file reproduced by said stream file reproducing means; and

reproduction control means for controlling reproduction of said stream files based on the plural types of said characteristic point information reproduced from the corresponding program information files by said characteristic point information reproducing means.

Claim 9 of U.S. Patent No. 6,697,566 does not disclose a characteristic point information including a number of streams used by a program, identification information of each stream, and attribute information of each stream corresponding to each identification information.

In an analogous art, Yogeshwar discloses characteristic point information including a number of streams used by a program, identification information of each stream, and attribute information of each stream corresponding to each identification information (see column 55, line 23 - column 56, line 9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have added a characteristic point information including a number of streams used by a program, identification information of each stream, and attribute information of each stream corresponding to each identification information taught by Yogeshwar into claim 9 of U.S. Patent No. 6,697,566 so that no errors will be visible in the encoded data (see column 2, lines 1 – 13).

4. Claims 24, 36, 48, 60, 72 and 84 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,697,566 in view of Yogeshwar et al (US 6,026,232).

Regarding **claims 24, 36, 48, 60, 72 and 84** of this application, claim 9 of U.S. Patent No. 6,697,566 recites a recording/reproducing apparatus, comprising:

stream file generation means for generating stream files containing video and/or audio signals; the stream files being composed of MPEG compressed video data;

characteristic point information generation means for generating plural types of characteristic point information from the video and/or audio signals contained in each stream file generated by said file generation means;

the characteristic point information including positional information indicating a user designated position and characteristic point information;

the characteristic point information being included in a program information file corresponding to each stream file and being used to access characteristic points when reproducing the stream files;

recording means for recording the stream files and corresponding program information files containing the plural types of characteristic point information in a recording medium, the program information files being recorded in a different area of said recording medium than the stream files;

the type of characteristic point information being correlated with a record position of the characteristic point information; stream file reproducing means for reproducing the stream files which contain video and/or audio signals recorded on said recording medium; characteristic point information reproducing means for reproducing the plural types of characteristic point information from a program information file corresponding to each stream file reproduced by said stream file reproducing means; and

reproduction control means for controlling reproduction of said stream files based on the plural types of said characteristic point information reproduced from the corresponding program information files by said characteristic point information reproducing means.

Claim 9 of U.S. Patent No. 6,697,566 does not disclose a receiving step of receiving a user operation indicative of the user designated position.

In an analogous art, Yogeshwar discloses a receiving step of receiving a user operation indicative of the user designated position (column 12, lines 47 – 57 discloses a user interface and a keyboard used to input parameters. Column 23, line 54 – column 24, line 9 discloses user operations of the user-designated positions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have added the receiving step of receiving user operation indicative of the user designated position taught by Yogeshwar into claim 9 of U.S. Patent No. 6,697,566 so that no errors will be visible in the encoded data (see column 2, lines 1 – 13).

Regarding **claims 17, 21, 25, 29, 33, 37, 41, 45, 49, 53, 57, 61, 65, 69, 73, 77, 81 and 85** of this application, claim 9 of U.S. Patent No. 6,697,566 does not disclose wherein the characteristic point information include at least one of a start point, an end point, and a scene change point of a program.

Yogeshwar discloses wherein the characteristic point information include at least one of a start point, an end point, and a scene change point of a program (see column 21, lines 13 – 30).

Regarding **claims 18, 22, 26, 30, 34, 38, 42, 46, 50, 54, 58, 62, 66, 70, 74, 78, 82 and 86** of this application, claim 9 of U.S. Patent No. 6,697,566 does not disclose wherein said characteristic point information further include an I-picture position of the program.

Yogeshwar discloses wherein said characteristic point information further include an I-picture position of the program (see column 60, lines 20 – 32).

It is noted that the process claimed can be performed by the apparatus of U.S. Patent No. 6,697,566.

5. Claims 19, 23, 27, 31, 35, 39, 43, 47, 51, 55, 59, 63, 67, 71, 75, 79, 83 and 87 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,697,566 in view of Kroon (US 6,438,083 B1).

Regarding **claims 19, 23, 27, 31, 35, 39, 43, 47, 51, 55, 59, 63, 67, 71, 75, 79, 83 and 87** of this application, claim 9 of U.S. Patent No. 6,697,566 does not disclose

wherein said characteristic point information further include a silent point of the program.

In an analogous art, Kroon discloses wherein said characteristic point information further include a silent point of the program (see column 11, line 60 – column 12, line 6 and column 12, line 65 – column 13, line 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have added the silent point of a program taught by Kroon into the claim 9 of U.S. Patent No. 6,697,566 so that information can be recorded at a faster rate than at the rate at which the information is supplied (see column 3, lines 10 – 15).

It is noted that the process claimed can be performed by the apparatus of U.S. Patent No. 6,697,566.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 16- 18, 20 - 22, 24 - 26, 28 - 30, 32 - 34, 36 - 38, 40 - 42, 44 - 46, 48 - 50, 52 - 54, 56 - 58, 64 - 66, 68 - 70, 72 - 74, 76 - 78, 80 – 82 and 84 – 86 are rejected under 35 U.S.C. 102(e) as being anticipated by Yogeshwar et al (US 6,026,232).

As to **claim 16**, Yogeshwar discloses a processing apparatus, comprising:

an encoder (50, 70) configured to encode video and/or audio signals to generate stream files; (see column 8, lines 28 – 31, column 9, lines 16 – 25 and column 10, line 66 – column 11, line 1);

a processor configured to generate characteristic point information including (see column 23, line 54 – column 24, line 9 and column 60, lines 20 – 32); characteristic point information including a number of streams used by a program, identification information of each stream, and attribute information of each stream corresponding to each identification information (see column 55, line 23 - column 56, line 9), the characteristic point information being included in a program information file (940) corresponding to each stream file and being used to access characteristic points when reproducing the stream files (see column 55, lines 23 – 42 and column 60, lines 11 - 13); and

a recording unit (52) configured to record the stream files and corresponding program information files containing the characteristic point information respectively in a recording medium;

As to **claim 20**, this claim is similar to claim 16 only in that claim 20 is a broader claim. Thus claim 20 is analyzed as previously discussed with respect to claim 16.

As to **claim 24**, this claim is similar to claim 16 only in that the limitation “a user interface configured to receive a user operation indicative of the user designated position” is additionally recited.

Yogeshwar discloses “a user interface (GUI) configured to receive a user operation indicative of the user designated position” (see column 12, lines 47 – 57).

As to **claim 28**, this claim is similar to claim 16 only in that claim 16 is an apparatus claim whereas claim 28 is a method claim. Thus method claim 28 is analyzed as previously discussed with respect to claim 16.

As to **claim 32**, this claim is similar to claim 20 only in that claim 20 is an apparatus claim whereas claim 32 is a method claim. Thus method claim 32 is analyzed as previously discussed with respect to claim 20.

As to **claim 36**, this claim is similar to claim 32 only in that the limitation “a receiving step of receiving a user operation indicative of the user designated position” is additionally recited.

Yogeshwar discloses “a receiving step of receiving a user operation indicative of the user designated position” (column 12, lines 47 – 57 discloses a user interface and a keyboard used to input parameters. Column 23, line 54 – column 24, line 9 discloses user operations of the user-designated positions).

As to **claim 40**, this claim is similar to claim 28 only in that the limitation “computer program encoded on a computer readable medium” is additionally recited.

Yogeshwar discloses computer software on a computer readable medium (see column 12, lines 47 – 57 and column 67, lines 45 - 66).

As to **claim 44**, this claim is similar to claim 32 only in that the limitation “computer program encoded on a computer readable medium” is additionally recited.

Yogeshwar discloses computer software on a computer readable medium (see column 12, lines 47 – 57 and column 67, lines 45 - 66).

As to **claim 48**, this claim is similar to claim 36 only in that the limitation “computer program encoded on a computer readable medium” is additionally recited.

Yogeshwar discloses a computer software on a computer readable medium (see column 12, lines 47 – 57 and column 67, lines 45 - 66).

As to **claim 52**, this claim is similar to claim 16 only in that the limitation “a controller configured to control reproduction of said stream files based on the characteristic point information reproduced from the corresponding program information files” and a “reproducing unit” is additionally recited.

Yogeshwar discloses a controller configured to control reproduction of said stream files based on the plural types of said characteristic point information reproduced from the corresponding program information files (see column 67, lines 22 – 26).

Yogeshwar also discloses a reproducing unit (see column 67, lines 9 – 34).

As to **claim 56**, this claim is similar to claim 52 only in that claim 56 is a broader claim. Thus claim 56 is analyzed as previously discussed with respect to claim 52.

As to **claim 64**, this claim is similar to claim 52 only in that claim 52 is an apparatus claim whereas claim 64 is a method claim. Thus method claim 64 is analyzed as previously discussed with respect to claim 52.

As to **claim 68**, this claim is similar to claim 56 only in that claim 56 is an apparatus claim whereas claim 68 is a method claim. Thus method claim 68 is analyzed as previously discussed with respect to claim 56.

As to **claim 72**, this claim is similar to claim 68 only in that the limitation "a receiving step of receiving a user operation indicative of the user designated position "is additionally recited.

Yogeshwar discloses "a receiving step of receiving a user operation indicative of the user designated position "(column 12, lines 47 – 57 discloses a user interface and a keyboard used to input parameters. Column 23, line 54 – column 24, line 9 discloses user operations of the user-designated positions).

As to **claim 76**, this claim is similar to claim 64 only in that the limitation "computer program encoded on a computer readable medium "is additionally recited.

Yogeshwar discloses a computer software on a computer readable medium (see column 12, lines 47 – 57 and column 67, lines 45 - 66).

As to **claim 80**, this claim is similar to claim 68 only in that the limitation "computer program encoded on a computer readable medium "is additionally recited.

Yogeshwar discloses a computer software on a computer readable medium (see column 12, lines 47 – 57 and column 67, lines 45 - 66).

As to **claim 84**, this claim is similar to claim 72 only in that the limitation "computer program encoded on a computer readable medium " is additionally recited.

Yogeshwar discloses a computer software on a computer readable medium (see column 12, lines 47 – 57 and column 67, lines 45 - 66).

As to **claim 17**, Yogeshwar discloses the processing apparatus according to claim 16, wherein said characteristic point information include at least one of a start point, an end point, and a scene change point of a program (see column 21, lines 13 –

30).

As to **claim 18**, Yogeshwar discloses the processing apparatus according to claim 17, wherein said characteristic point information further include an I-picture position of the program (see column 60, lines 20 – 32).

Grounds for rejecting claim 17 apply for **claims 21, 25, 29, 33, 37, 41, 45, 49, 53, 57, 65, 69, 73, 77, 81 and 85** in its entirety.

Grounds for rejecting claim 18 apply for **claims 22, 26, 30, 34, 38, 42, 46, 50, 54, 58, 66, 70, 74, 78, 82 and 86** in its entirety.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 19, 23, 27, 31, 35, 39, 43, 47, 51, 55, 59, 67, 71, 75, 79, 83 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yogeshwar et al in view of Kroon (US 6,438,083 B1).

As to **claim 19**, Yogeshwar discloses the processing apparatus according to claim 17, but does not disclose wherein said characteristic point information further include a silent point of the program.

Kroon discloses wherein said characteristic point information further include a silent point of the program (see column 11, line 60 – column 12, line 6 and column 12, line 65 – column 13, line 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have added the silent point of a program taught by Kroon to the apparatus of Yogeshwar so that information can be recorded at a faster rate than at the rate at which the information is supplied (see column 3, lines 10 – 15).

Grounds for rejecting claim 19 apply for claims **23, 27, 31, 35, 39, 43, 47, 51, 55, 59, 67, 71, 75, 79, 83 and 87** in its entirety.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 5,805,762 discloses Intra coding.

US 6,198,877 B1 discloses recording methods.

US 6,288,989 B1 discloses an information recording method.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Oluwaseun A. Adegeye whose telephone number is 571-270-1711. The examiner can normally be reached on Monday - Friday 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on 571-272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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01/03/2007

O.A

Marsha D Banks-Harold

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